

### **REMARKS**

Claims 1-2, 4-6, 8, 11 and 13 are currently pending in the application, of which claims 1 and 5 are independent claims. Applicants request reconsideration and timely withdrawal of the pending rejections for the reasons discussed below.

#### ***Rejections Under 35 U.S.C. § 103***

Claims 1, 2, 4-6, 8, 11, and 13 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U. S. Patent No. 6,391,137 issued to Matsushima ("Matsushima"), in view of U. S. Patent No. 6,908,638 issued to Ueda, *et al.* ("Ueda").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the reference or references, when combined, must disclose or suggest all of the claim limitations. The motivation to modify the prior art and the reasonable expectation of success must both be found in the prior art and not based upon a patent applicant's disclosure. *See in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Office Action fails to establish a prima facie case of obviousness over claims 1-2, 4-6, 8, 11 and 13 because there is insufficient suggestion or motivation to modify the references.

The examiner concedes that Matsushima "does not expressly teach ... in the prior art method" every feature of the present invention. Specifically, Matsushima's prior art fails to disclose at least "completely covering each lateral side of the combined upper and lower substrates with an unetchable protection film." See Office Action, page 3, lines 1-3. The examiner then looks to an embodiment of Matsushima's invention, shown in Matsushima's Fig. 3 and Fig. 4, to modify Matsushima's prior art. The examiner submits that it would have been

obvious to modify Matsushima's prior art to "prevent etchant from entering the gap between the upper and lower substrates during etching." Applicants disagree.

As explained by the Court of Appeals for the Federal Circuit, the proper inquiry when determining whether there is a motivation or suggestion to combine the references is "whether there is something in the prior art as a whole to suggest the *desirability*, and thus the obviousness, of making the combination." MPEP, Chapter 2143.01 (citing to In re Fulton, 391 F.3d 1195, 1200-01 (Fed. Cir. 2004)) (emphasis in original). Moreover, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP, Chapter 2143.01.III (citations omitted, emphasis in original). Applicants submit that the examiner has failed to establish the "*desirability*, and thus the obviousness, of making the combination" of Matsushima's prior art and an embodiment of Matsushima's invention.

In Matsushima's prior art, etchant is prevented from entering the gap between the substrates by periphery sealing member 4. See Matsushima, col. 2, lines 43-45. Thus, no modification to Matsushima's prior art is necessary to achieve this purpose. Furthermore, while Matsushima provides numerous drawbacks to the prior art method, see e.g. col. 3, lines 20-28, lines 33-34, and lines 38-41, none of these drawbacks even remotely relate to etchant entering the gap between the substrates. Therefore, it is evident that the problem to be solved, according to the examiner's purported motivation, was in fact non-existent in the prior art. Further, a purported motivation or suggestion to modify a reference to solve a non-existent problem is insufficient to establish a prima facie case of obviousness since there would be no "*desirability*" for making the modification.

Absent this modification of Matsushima's prior art, Matsushima fails to disclose or suggest all features of claims 1 and 5. Specifically, the Matsushima fails to disclose or suggest

at least “completely covering each lateral side of the combined upper and lower substrates with an unetchable protection film,” as recited in both claims 1 and 5.

Further, Ueda is not directed to a method of etching a substrate, and thus fails to remedy the shortcomings of Matsushima with respect to claims 1 and 5.

Accordingly, for at least these reasons, the cited references cannot support a prima facie case of obviousness over the present invention.

Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicants respectfully submit that independent claims 1 and 5, and all the claims that depend therefrom, are allowable. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1, 2, 4-6, 8, 11, and 13.

**CONCLUSION**

Applicants believe that a full and complete response has been made to the pending Office Action and respectfully submit that all of the stated grounds for rejection have been overcome or rendered moot. Accordingly, Applicants respectfully submit that all pending claims are allowable and that the application is in condition for allowance.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicants' undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

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